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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,335	11/16/2005	Tim Cheeseright	DYOUNG0287US	8953
23908 7590 12/09/2008 RENNER OTTO BOISSELLE & SKLAR, LLP 1621 EUCLID AVENUE NINETEENTH FLOOR CLEVELAND, OH 44115				
EXAMINER				
SKOWRONEK, KARL HEINZ R				
ART UNIT		PAPER NUMBER		
1631				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/526,335

**Applicant(s)**

CHEESERIGHT ET AL.

**Examiner**

KARLHEINZ R. SKOWRONEK

**Art Unit**

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Status***

Claims 1-13 and 16 are pending.

Claims 14 and 15 are cancelled.

Claims 1-13 and 16 are being examined.

Claims 1-13 and 16 are rejected.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following rejection is reiterated from the previous office action.

Claims 1-13 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-13 and 16 are drawn to a process. A statutory process must include a step of a physical transformation, or produce a useful, concrete, and tangible result (State Street Bank & Trust Co. v. Signature Financial Group Inc. CAFC 47 USPQ2d 1596 (1998), AT&T Corp. v. Excel Communications Inc. (CAFC 50 USPQ2d 1447 (1999)). The instant claims do not result in a physical transformation, thus the Examiner must determine if the instant claims include a useful, concrete, and tangible result.

As noted in State Street Bank & Trust Co. v. Signature Financial Group Inc. CAFC 47 USPQ2d 1596 (1998) below, the statutory category of the claimed subject

matter is not relevant to a determination of whether the claimed subject matter produces a useful, concrete, and tangible result:

The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter--but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. See *In re Warmerdam*, 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994). For purpose of our analysis, as noted above, claim 1 is directed to a machine programmed with the Hub and Spoke software and admittedly produces a "useful, concrete, and tangible result." *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557. This renders it statutory subject matter, even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss.

In determining if the claimed subject matter produces a useful, concrete, and tangible result, the Examiner must determine each standard individually. For a claim to be "useful," the claim must produce a result that is specific, and substantial. For a claim to be "concrete," the process must have a result that is reproducible. For a claim to be "tangible," the process must produce a real world result. Furthermore, the claim must be limited only to statutory embodiments.

Claims 1-13 and 16 do not require production of a tangible result in a form that is useful to the user of the process or apparatus. The claims are directed to a method of comparing molecules that involves using a calculated field of potentials for a first molecule and comparing the field of potentials for a second molecule relative to the first molecule by combining values of the potential fields to provide a score of similarity. The phrase "to provide a score" does not produce a tangible result in that it is not returned to the practitioner of the method. Under a broad but reasonable interpretation of the phrase "to provide a score", the phrase sets forth that the combining step is a scoring mechanism but stops short of producing a tangible result. A tangible result requires that

the claim must set forth a practical application to produce a real-world result. This rejection could be overcome by amendment of the claims to recite that a result of the process is outputted to a display, or to a user, or in a graphical format, or in a user readable format, or by including a result that is a physical transformation. The applicants are cautioned against introduction of new matter in an amendment.

### ***Response to Arguments***

Applicant's arguments filed 10 September 2008 have been fully considered but they are not persuasive. Applicant maintains that the resultant score of the method is a tangible output. Applicant asserts that the score of the computer implemented method will reside in a computer buffer. However, a score residing in a computer buffer is not tangible to the practitioner of the method and cannot be realized by the practitioner until the score is further acted upon. It is the further action that renders the score tangible. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a computer buffer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). With respect to applicant's comparison of the instant claims to the claims of US PAT 6,996, 476, the comparison is irrelevant and will not be discussed further. The instant application is independent of the claims of US PAT 6,996, 476 and is being evaluated on its own merits. The rejection is maintained.

Claim 13 is directed to an article of manufacture in the form of a computer readable recording medium. As guided by the specification (page 9, line 13-21) a computer readable medium may be a carrier signal:

A further aspect of the invention provides a computer interpretable medium bearing a set of instructions for carrying out the methods of the invention. The computer interpretable medium may be a signal carrier medium, for example an electrical signal carried along a conductive path, an optical signal carried along an optical fibre, or a wireless signal carried in the air, as used to distribute computer readable instruction sets from computer to computer within and between jurisdictions. The computer interpretable medium may also be a recording medium, for example a magnetic or optical storage medium, or a latent or non-latent computer memory device.

The specification teaches at p. 9, the computer readable medium bears a set of instruction for carrying out the methods of the invention. At p. 9 line 19, the specification instructs a computer readable medium may also be a recording medium. In light of the guidance provided by the specification, a recording medium may also be a carrier signal. Claim 13 is rejected as being non-statutory because it reads on a natural phenomenon and thus is non-statutory.

### ***Response to Arguments***

Applicant's arguments filed 10 September 2008 have been fully considered but they are not persuasive. Applicant argues the claim as written supports the interpretation that the claim is directed to media such as magnetic or optical storage medium and not carrier signal. The argument is not persuasive because the definition of a computer interpretable storage medium is not limited to only magnetic or optical physical, storage devices, such as magnetic disks, and can therefore be also interpreted to also be a carrier signal. Furthermore the specification does not define the

term storage medium. As a result, the term storage medium can be interpreted broadly. The rejection is maintained.

The following is a new ground for rejection.

Claims 1-12 are directed to a process of comparing molecules. The following analysis is taken from the guidance provided in the MPEP at 2104.IV, "Determine Whether the Claimed Invention Complies with 35 USC101". The claims are directed to a process. Here the claims are directed to the abstract idea of mathematically comparing a first molecule to a second molecule that results in an enumerated measure of similarity. The processes do not recite a physical transformation of matter from one state to another. Giving the claims the broadest reasonable interpretation, the claims read on mental steps. In *Comiskey* (*In re Comiskey*, 84 USPQ2d 1670) the court established that "the application of human intelligence to the solution of practical problems is not and of itself patentable" (at 1680). In *Comiskey*, the court stated explicitly "mental processes - or processes of human thinking - standing alone are not patentable even if they have a practical application" (at 1679). The court in *Comiskey* stated, "Following the lead of the Supreme Court, this court and our predecessor court have refused to find processes patentable when they merely claimed a mental process standing alone and untied to another category of statutory subject matter even when a practical application was claimed" (at 1680). The court's recent decision in *In re Bilski* confirmed, "a process is patent-eligible under 35 USC 101 if it is tied to a particular machine or apparatus or if it transforms a particular article into a different state or thing"

(*In re Bilski*, 88 USPQ at 1391, 2008). In the instant claims, the process is not tied to a particular machine. Rather, the claim, in its preamble recites, the intended use of computer implementation. The intended use does not “breathe life and meaning” to the claim and does not limit the claim. Thus in the absence of an explicit tie to a particular machine or a step of physical transformation in the performance of the method, the claims are directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

#### ***Response to Arguments***

Applicant's arguments, see Remarks p 6-9, filed 10 September, with respect to the rejection of claims 1-13 and 16 over Ashworth have been fully considered and are persuasive. The rejection of claims 1-13 and 16 has been withdrawn in view of applicants' argument that Ashworth fails to show a step to determine field values based on the field of a second molecule that are constrained to the positions of the field points (a pharmacophore) of a first molecule.

#### ***Conclusion***

None of the currently pending claims are in allowable condition.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARLHEINZ R. SKOWRONEK whose telephone number is (571)272-9047. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm (EST).



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie A. Moran can be reached on (571) 272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KARLHEINZ R SKOWRONEK/  
Examiner, Art Unit 1631  
11 December 2008